

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBIN E. WRIGHT

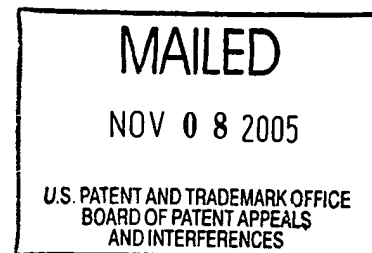
Appeal No. 2005-2399
Application No. 09/808,610

HEARD: October 19, 2005

Before GARRIS, WARREN and WALTZ, **Administrative Patent Judges**.
WALTZ, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 19 through 35. Claims 1 through 18 are the remaining claims pending in this application and stand withdrawn from consideration as directed to a non-elected invention (Brief, page 1; final Office action dated Apr. 29, 2003, page 1). We have jurisdiction pursuant to 35 U.S.C. § 134.



According to appellant, the invention is directed to a roll of pressure sensitive adhesive tape that includes a first non-tacky edge face, a second edge face, and a coating disposed on the first edge face, where the coating includes the reaction product of an acrylate oligomer, a polyetheracrylate oligomer, and optionally a monomer, a photoinitiator or a combination thereof (Brief, pages 1-2). Representative independent claim 1 is reproduced below:

1. A roll of pressure sensitive adhesive tape comprising
 - a first nontacky edge face;
 - a second edge face opposite said first edge face;and
 - a coating disposed on said first edge face, said coating comprising the reaction product of
 - a) acrylate oligomer;
 - b) polyetheracrylate oligomer; and
 - c) optionally monomer, photoinitiator or a combination thereof.

The examiner has relied upon the following references as evidence of obviousness:¹

¹The examiner has also listed Fuhr et al., U.S. Patent No. 4,528,307 (not "JP" as recited on page 3 of the Answer), Schaefer et al., U.S. Patent No. 5,208,311, and Schunck, U.S. Patent No. 5,460,857, as "Prior Art of Record" (Answer, page 3, ¶(9)). Although discussed for the first time on pages 6-8 of the Answer, the examiner has not listed these references in the statement of the rejection (Answer, page 3). Accordingly, we do not consider these references as part of the examiner's evidence of obviousness. See *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970); *Ex parte Raske*, 28 USPQ2d 1304, 1304-05 (Bd. Pat. App. & Int. 1993); Reply Brief, pages 2, 5, 10 and 12. We also note that the examiner has listed an incorrect patent number for Schaefer et al. on page 8 of the Answer (see the Reply

Park	4,151,056	Apr. 24, 1979
Ijishi et al. (JP '353) (published Japanese Patent Application) ²	50-10353	Apr. 21, 1975

Claims 19-35 stand rejected under 35 U.S.C. § 103(a) as unpatentable over JP '353 in view of Park (Answer, page 3). Based on the totality of the record, we reverse this rejection on appeal essentially for the reasons stated in the Brief, Reply Brief, and those reasons set forth below.

OPINION

The examiner finds that JP '353 discloses a cured coating formed from a solution of a photosensitizer, a photoactive crosslinking agent, and a vinyl-based polymer where the coating is applied to the edge face of a variety of tapes which have adhesive at their edge face, such as a pressure sensitive adhesive tape (Answer, page 3). The examiner further finds that JP '353 teaches application of an activating beam of radiation to the coated surface of the edge face to carry out crosslinking and form a cured layer, thus preventing the problem of "oozing" of the adhesive at the edge face of the adhesive tape (Answer, sentence bridging pages 3-4). The examiner recognizes that JP '353 fails to teach forming

Brief, page 12).

²We refer to and cite from a full English translation of this document, previously made of record.

a cured coating "of a solvent-free composition of acrylate oligomer, polyetheracrylate oligomer, and optional monomer and photoinitiator" (Answer, page 4). Therefore the examiner applies Park, directed to a radiation curable coating composition that is essentially free of volatile solvents, for the teaching of a radiation curable coating composition of a radiation reactive oligomer, a radiation reactive diluent (monomer), a photoinitiator, and optionally a radiation reactive crosslinker (Answer, page 4). The examiner finds that Park generically teaches the use of "virtually any monomer or oligomer" as the radiation reactive component (Answer, page 5). The examiner recognizes that Park "lacks a specific teaching of using a mixture of the acrylate oligomer and the polyetheracrylate oligomer" but the examiner notes that it is prima facie obvious "to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the same purpose" (*id.*). From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in the art of radiation curable coatings at the time of appellant's invention to "modify" the coating solution of JP '353 with a "well known" radiation curable coating composition of acrylate oligomers, polyetheracrylate oligomers, and monomeric (meth)acrylate esters,

"motivated by desire to obtain an easy and rapid coating process, which is solvent-free and also reduces energy consumption, so as to meet the increasing restriction requirements, as taught by Park" (Answer, paragraph bridging pages 5-6).

We determine that the examiner's obviousness conclusion is not based on an adequate factual record. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) (Where the legal conclusion of obviousness is not supported by facts, it cannot stand). As correctly argued by appellant (Brief, pages 4-5), it is undisputed that JP '353 fails to disclose or suggest the claimed coating composition of at least an acrylate oligomer and a polyetheracrylate oligomer³ and appellant submits that the examiner has failed to identify any disclosure of the claimed coating composition in Park. The examiner's only identification of any polyetheracrylate component is the citation of col. 3, ll. 26-42, of Park where Park teaches that a hydroxyl-terminated polyetheracrylate (a monomer) is used as a reactant to form an acrylate-capped polyurethane oligomer (Answer, page 5; see especially col. 3, ll. 39-45, of Park). Although the examiner

³We note that JP '353 discloses a coating composition including a vinyl-based polymer such as an acrylic acid-acrylate copolymer (page 6) and a photoactive crosslinking agent such as polyethylene glycol dimethacrylate (a polyetheracrylate monomer; see page 5 and Example 2).

refers to a generic disclosure of possible components by Park (Answer, page 5, citing col. 1, ll. 28-32), this teaching is from the "prior art" (see col. 1, ll. 30-31). A slightly more narrow disclosure of possible components is disclosed by Park at col. 3, ll. 16-20, but nothing in this disclosure teaches or suggests the specific oligomer composition required by claim 19 on appeal.⁴

Even assuming *arguendo* that the references disclose each oligomer of the claim 19 coating composition, the examiner has failed to convincingly establish any reason, suggestion or motivation for the proposed combination of references. See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. [Citations omitted]." *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). As correctly argued by appellant (Reply Brief, page 3), the examiner's rationale that it is *prima facie* "obvious to combine two *compositions...*" in order to form a third composition useful for the same purpose (Answer, page 5, italics

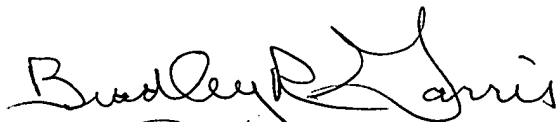
⁴Although not discussed by the examiner nor appellant, we note that Park teaches various polyetheracrylate monomers as crosslinking agents for radiation curable compositions (col. 4, ll. 32-61).

added) is applicable to compositions or mixtures while the claimed subject matter is directed to reaction products of at least two components. See *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980); *In re Crockett*, 279 F.2d 274, 276, 126 USPQ 186, 188 (CCPA 1960). Additionally, the examiner has not presented any convincing evidence as to why one of ordinary skill in the art would have substituted the radiation curable composition taught by Park for the coating composition disclosed by JP '353. As correctly argued by appellant (Brief, pages 6-7), Park is directed to a solvent-free radiation curable composition (col. 5, ll. 39-44) while JP '353 requires a solvent and attempts to solve the problem of "oozing" of adhesive in a roll of pressure sensitive adhesive tape (pages 4 and 6). We note that JP '353 is directed to a radiation curable solution dispersed on the edge face of a pressure sensitive adhesive tape while Park is merely directed to radiation curable compositions in general. The examiner has not established that the substitution of the radiation curable composition of Park would have had a reasonable expectation of success as the coating solution on the edge face of the tapes disclosed by JP '353. See *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

For the foregoing reasons and those set forth in the Brief and Reply Brief, we determine that the examiner has not established a prima facie case of obviousness in view of the reference evidence. Therefore we cannot sustain the examiner's rejection of the claims on appeal under section 103(a) over JP '353 in view of Park. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The decision of the examiner is reversed.

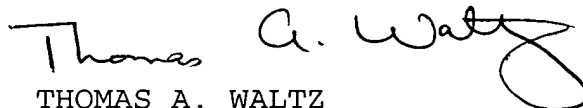
REVERSED



BRADLEY R. GARRIS
Administrative Patent Judge



CHARLES F. WARREN
Administrative Patent Judge



THOMAS A. WALTZ
Administrative Patent Judge

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